

**Remarks**

Claims 1-3, 6, 9-15, 17-22 and 36 are currently pending in the instant application. Claims 1 and 23 are independent. Reconsideration of this Application is respectfully requested.

**Allowable Subject Matter**

The Examiner states that claims 13 and 17-22 are objected to, but set forth allowable subject matter. The Examiner respectfully requested referred to Paragraph 7 of the Office Action dated February 12, 2003.

✓ The Applicants are of interest as to why the Examiner has maintained the objection in relation to the indicated claims. The Examiner is respectfully reminded that both dependent claims 17 and 20 were amended in the Amendment submitted November 22, 2002 in order to ensure that they properly depend from independent claim 1. Therefore, it is believed that the objection of claims 17-22 should be withdrawn.

✓ With regard to dependent claim 13, careful consideration from the previous office actions reveal that this claim has not been objected to by the Examiner. Therefore, the Examiner's indication that claim 13 remains objected to appears to be incorrect.

✓ The Examiner is respectfully requested to clarify the statement made in Paragraph 7 of the Office Action dated February 12, 2003. The Applicants would appreciate this clarification in the Examiner's next communication associated with the instant application.

**Claim Rejections Under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(a)**

Claims 1-3, 6, 9-15, 17-22 and 36 stand rejected under 35 U.S.C. §102(a) as being anticipated by Saito, et al., U.S. Patent No. 6,124,666. Additionally, claims 1 and 20 stand rejected under 35 U.S.C. §102(e) as being anticipated by Buxbaum, U.S. Patent No. 4,274,030. Finally, claims 14 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Saito, et al. These rejections are respectfully traversed.

As previously discussed, the Examiner indicated in Paragraph 7 of the current Office Action that claims 13 and 17-22 set forth allowable subject matter. However, the Examiner has also rejected claims 13 and 17-22 under 35 U.S.C. §102(a) in view of Saito, et al. The Examiner is respectfully requested to clarify this apparent discrepancy.

Regarding the rejections under §102(e), the Examiner has admitted both Saito et al. and Buxbaum fail to teach the limitation of “said buffer inhibiting interaction of said admissive layer and said substrate by one of altering, altering and blocking said substrate.” This limitation is set forth in independent claim 1 of the instant Application. However, the Examiner has failed to give patentable weight to this indicated limitation of independent claim 1.

Applicants respectfully submit that the Examiner’s position that the indicated recitation sets forth functional language that should not be given patentable weight is improper. That is, it is the Applicant’s position that (1) the disputed limitation sets forth positive and non-narrative subject matter which must be properly considered by the Examiner, and (2) even if the Examiner were to have an arguable position with regard to the disputed limitation, functional limitations are considered proper claim language.

In *In re Echerd*,<sup>1</sup> the Court held that “there is nothing inherently wrong in defining something by what it does rather than what it is.” There are several cases to the same effect.<sup>2</sup> The Court of Appeals for the Federal Circuit has been holding that no limitation or wording anywhere in the claim can be ignored in determining patentability.<sup>3</sup> In the *Echerd* case, as was typical of a great many cases in the past, the Patent and Trademark Office rejected the claim as anticipated by prior art, or as obvious, were all of the specific structure claimed was old and all of the novelty resided solely in the functional statement, such as negative limitations, or mental steps. The Federal Circuit is now holding such rejections improper as not consistent with statute.<sup>4</sup>

One such example where the Court has found that functional limitations are proper is the *Ludtke* case.<sup>5</sup> In the *Ludtke* case, the claim at issue was directed to a parachute canopy comprising of various elements. In particular, one such element set forth in the claim is:

said plurality of lines providing a radial separation between each of said panels upon deployment [of the parachute] creating a region of high porosity between each of said panels such that the critical velocity...would be less than...

The indicated claim language from the *Ludtke* case may be considered as classical functional language. This functional language was indicated in the *Ludtke* case as being proper subject matter which must be considered by the Examiner.

Turning now to the instant application, as indicated hereinabove, independent claim 1 sets forth “said buffer inhibiting interaction of said admixive layer and said substrate by way of one of altering, and altering and blocking said substrate.” Remarkably, this language, with the use of the

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<sup>1</sup> *In re Echerd*, 176 USPQ (BNA 321 (C.C.P.A. 1973).

<sup>2</sup> *In re Hallman*, 210 USPQ (BNA) 609, 611 (C.C.P.A. 1971); *In re Ludtke and Sloan*, 169 USPQ (BNA) 563 (C.C.P.A. 1971); and *In re Swinehart and Sfiligoj*, 169 U.S.P.Q. (BNA) 226 (C.C.P.A. 1971).

<sup>3</sup> *In re Stencel*, 828 F.2d 751 (Fed. Cir. 1987).

<sup>4</sup> See *In re Stencel*, 828 F.2d 751 (Fed. Cir. 1987).

phrase *inhibiting*, is very similar to that which was considered in the *Ludtke* case. In accordance with the results in the *Ludtke* case, Applicants respectfully submit that the Examiner must give the disputed language in independent claim 1 patentable weight.

In view of the above, Applicants respectfully submit that due to the deficiencies of Saito et al. and Buxbaum, the Examiner must find that independent claim 1 is allowable over the relied upon patent documents. With regard to the rejected dependent claims, Applicants respectfully submit that these claims are allowable at least due to their dependence upon allowable independent claim.

### CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite the prosecution of this application, the Examiner is invited to telephone Timothy R. Wyckoff (Reg. No. 46,175) at (703) 390-3030 in the Washington D.C. area.

Prompt and favorable consideration of this Request for Reconsideration is respectfully requested.

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<sup>5</sup> *In re Ludtke and Sloan*, 169 USPQ (BNA) 563 (C.C.P.A. 1971).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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